Osterheld, as the Office Action states, does not disclose the steps of terminating the slurry dispense and rotating the pad a second speed during spraying. The claimed invention was developed through experimentation not taught by *Osterheld.* Refer to FIGS. 7 and 8. The claimed invention achieved a reduction of defect density of about 15.15% (from 0.25 defects/μm^2 to about 0.21 defects/μm^2) and a reduction in the standard deviation of the process from 8.2% to about 6.1%. The lower standard deviation indicates better repeatability of the process.

Osterheld does not suggest or teach Applicants' claimed invention. Applicants' have addressed "*a need for a method and/or apparatus which will quickly remove the slurry from the pad, thus more accurately controlling the removal rate of the substrate.*" (Paragraph 2, Page 3). *Osterheld et al.* has not suggested the solution to the aforementioned need. In that,

> A patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the subject matter as a whole which should always be considered in determining the obviousness of an invention under 35 USC §103. *(In re Sponnable, 405 F. 2d 578, 160 USPQ 237 (CCPA 1969))*

Additionally, the Office Action's assertion that "*the steps of terminating the slurry dispense and rotating the pad at a second speed during spraying, would have been obvious. . .since a computer could be programmed to perform this [sic] steps on the basis of the user's preference as a matter of obvious design choice (Office Action Page 3, Paragraph 1)*" lacks support from the cited reference. Whether a computer could be programmed to perform steps in a process does not support the premise of a *prima facie* case of obviousness under §103. Furthermore, the Office Action cites *Osterheld, "A polishing step and recipe are selected to polish the desired material(s) to achieve desired results. Multiple polishing steps, recipes, pads etc. can be employed to achieve these results."* (col. 8, lines 28 – 30). From Osterheld's statement, one skilled in the art is not taught Applicants' claimed invention. There may be a myriad of solutions possible with each solution requiring experimentation. However, without further detail and enablement, it is unlikely one skilled in the art would be able to infer Applicants' claimed invention based on *Osterheld* without having performed undue experimentation.

Consequently, there must be a basis in the art for combining or modifying references. Applicants' claimed invention with the steps of terminating the slurry dispense and rotating the pad a second speed during spraying is not suggested by *Osterheld et al.* MPEP §2143.01 provides:

> The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills, 916 F.2d680, 16 USPQ2d 1430 (Fed. Cir. 1990)*

Assuming that "*it is within the general skill of a worker in the art to discover the optimum or workable ranges on the basis of their suitability for the user's preference as a matter of obvious design choice (Office Action Page 3).*" There is no basis from the cited reference to discover Applicant's optimum workable ranges. An "Obvious to Try" modification does not establish *prima facie* obviousness *(In re Clinton, 527, F. 2d 1226, 188USPQ 365)*

In that the Office Action has failed to establish a case of *prima facie* obviousness, claims 1 – 20 are allowable over the cited reference. Applicants believe that the §103 rejections have been addressed.

Applicants believe they have addressed the Examiner's concerns and believe that the case is in a condition for allowance. Applicants respectfully reiterate their request that a patent be allowed to issue.

Please charge any fees other than the issue fee and credit any overpayments to Deposit Account 14-1270.

Respectfully submitted,

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